

## **REMARKS**

Claims 1, 6-8, 18, 22, 27, 29, 31-33, 37, 39 and 42 have been amended. Claims 1-44 are pending in the application.

### **Specification Objections**

The specification is objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. Applicant respectfully traverses this rejection.

The specification and the drawings disclose various computer products that support claims 33-41. For example, Figures 1, 2 and 3 disclose various devices that are computer products. These products may run computer software programs, such as iChat™, AIM™, etc. see for example, Specification, page 10, ¶¶[0032]-[0033]. The hardware structures, e.g., processors, memory, etc, of the peers are described in page 10, ¶[0032] and is inherently present, as would be known to those skilled in the art upon a reading of the present disclosure, in the devices illustrated in Figure 1. Those skilled in the art having benefit of the present disclosure would readily recognize the devices that are capable of running programs such as iChat™, AIM™ indeed are an exemplary disclosures that support the claimed devices, e.g., computer program products. Therefore, based upon the exemplary embodiments disclosed in the specification, those skilled in the art would find, explicitly and/or implicitly, all of the elements of the computer program products comprising computer-readable medium, as called for by claims 33-41.

### **Claims Rejections Under 35 U.S.C. 112**

The Examiner rejected claims 4, 5 and 24 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Applicant respectfully traverses this rejection. Applicant respectfully asserts that the use of the term “substantially” does not render the term indefinite. The Examiner

rejects to claims 4, 5 and 24 by objection to the use of the language “substantial,” which the Examiner claims is a relative term and thus, allegedly causes these claims to be indefinite. As the court indicates in *Andrew Corp. v. Gabriel Electronics*, an “imprecise claim limitation, such as the phrase ‘about 100% per second’” does not impart invalidity to the claims, but is to be considered in determination of infringement.” 847 F. 2d 819, 821-22 (C.A. Fed. 1988). The same reasoning applies to the term “substantially,” which even though may or may not be somewhat imprecise, is not indefinite and would be valid. The imprecision of the term in question is negated and made understandable when those skilled in the art view claims 4 and 5 and 24 in the context of the entire claim and the specification. For example, because the data transfer in claims 4 and 5 and 24 takes place over a network, there is some inherent latency involved in the data transmission. As such, the resulting time lapse may mean the stream is not in perfect sync with the portion of the active content currently active to the first application module. Therefore, claims 4, 5 and 24 are not indefinite and are allowable for at least the reasons cited herein. Applicant respectfully requests this rejection be withdrawn.

#### **Claims Rejections Under 35 U.S.C. 101**

The Examiner rejected claims 1-21, 42-44 under 35 U.S.C. 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Examiner rejected claim 1 for having recited a system comprising a sender peer and a recipient peer, wherein each peer comprising modules. The Examiner asserts that because the Specification recites that “in general, a peer is some type of computing device (physical or virtual),” the claim is allegedly strictly software due to the reference to the “virtual” description. However, Examiner’s own assertion indicates that the disclosure in the Specification recites that the computing device may be **physical**. Further, virtual components may also be linked with

physical components. Nevertheless, the Specification clearly describes that a peer may be a “physical device.” Since it is undisputed that the “sender peer” includes an embodiment that is described to be physical, it is of proper statutory subject matter. The “virtual” embodiment does not change this fact. The Examiner has not provided authority that would indicate that in the case where it is undisputed that one embodiment of the claim term is of proper subject matter, other embodiments could possibly cause this claim to be of non-statutory subject matter. Claim 1 does not strictly reference a software structure, rather claim 1 is directed to statutory subject matter as defined in the specification. Similar reasoning also applies to the term “recipient peer.” Further, since the recipient peer and sender peer are of proper subject matter, whether sub-elements relating to these terms (*e.g.*, first and second chat modules) are software or hardware in nature is of no moment since it is proper to claim an apparatus that has various characteristics, including hardware and software features. For at least these reasons, claim 1 is in full compliance with the requirements of 35 U.S.C. §101.

Regarding rejection of claim 42, the Examiner asserts that “recipient chat module” can be a software module and, thus, not statutory subject matter. However, this is not the case since the claim specifically calls for the recipient chat module comprising a communications module and a client module, clearly, these modules include embodiments that have physical entities and, thus, the recipient chat module is clearly not solely a software module. Therefore, claim 42 of the present invention includes statutory subject matter. Accordingly, claim 42 of the present invention includes statutory subject matter and is allowable for at least the reasons cited herein.

Regarding the Examiner’s rejections of claims referencing computers, claims 1-21 clearly recite a system for sharing information about an active content of a sender peer with a recipient peer. The system of claim 1 includes a sender peer that comprises an application module and a

chat module. Thus, the system is a tangible object and is novel and is statutory subject matter. Regarding claims 42-44, the claims specifically call for a recipient chat module in a system for sharing active content between a plurality of peers. Again, a tangible system is referenced in these claims, and thus, contain tangible subject matter and not merely a computer program. Applicant respectfully submits that the original claim language meets all standards of 35 U.S.C. §112. Therefore, claims 1-21 and 42-44 are allowable for at least the reasons cited herein.

### **Claims Rejections Under 35 U.S.C. 102**

The Examiner rejected claims 1, 22 and 33 under 35 U.S.C. 102(a) as being anticipated by WIPO WO 03/050659 (**Gore**). Applicant respectfully traverses this rejection.

The **Gore** disclosure does not read upon the elements of claim 1 (as amended) of the present invention. For example, **Gore** discloses a system where each individual client computer includes a CD player or a DVD player, which it refers to as the media. **Gore** discloses that a server is capable of synchronizing the operation of the media and that a separate chat window may be provided where users can communicate among one another. However, each individual user invokes the media locally on their respective client computers. The chat room of **Gore** is provided for communicating peripheral information regarding the operation of the media, and not the content of the media. **Gore** discloses that synchronization of the operations of the media on the local computers is performed via a server computer, to which the client computer sends information. That is, **Gore** is directed to a third entity (*i.e.*, a server) to moderate and synchronize the interaction between two chat modules on two separate computers. Accordingly, **Gore's** disclosure is in contrast to claim 1 of the present invention, which calls for a first application module for activating and outputting active content from the data file, and a first chat module for

sending the active content, and a second chat module for receiving an output of the active content on the second sender peer. **Gore** does not perform these steps.

**Gore** does not teach the claimed feature of a first chat module for sending the active content. The Examiner states in the Final Office Action that “*information* must be sent from the user's computer in order for the other users to be able to view such *information*. As shown in Figure 12, the chat module is clearly used to provide *information* about what the clients are listening to. See element 194.” (emphasis added). See Final Office Action, p.28. Thus, **Gore** teaches sending *information related* to what a client is listening to, not *what* the client is actually listening to. In fact, **Gore** is silent with respect to sending/receiving actual active content, as called for in claim 1. In contrast to **Gore**, claim 1 calls for a first chat module, communicatively coupled to the first application module, for sending the active content.

**Gore** does not teach the claimed feature of a sender peer comprising a first application module, for activating and outputting to the receiving peer. **Gore** discloses a chat communication between that first user and the second user and a server using media information from the first user and other media information from the second user to synchronize the second user with the first user. See **Gore**, Figure 4, page 20, line 23 – page 22, line 6. The client operation described by **Gore** merely refers to operating the media locally and in gaining access to a server to provide server-specific information. The server is then prompted to provide the media information for logging purposes. Accordingly, in **Gore**, the chat module is not used to provide the data (*i.e.*, active content), as called for in claim 1. In **Gore**, it is the server provides that the data. The inference that simply because the second chat module receives some information, the first chat module *must* have sent the information to the second client is an incorrect one, and is not supported by evidence. The Office is unable to

point to any evidence to support this conclusion. *Gore* teaches that the *server* receives the media information from the first and second clients and may synchronize the clients. See *Gore*, Fig. 4 (132-134). A careful reading of Figure 4 reveals that the server in *Gore* stores the media information of the clients. Applicant respectfully submits that the Office has overlooked the fact that while certain data may be arriving at the receiving client computer, *Gore* **does not teach** that the first chat module performs the sending of the media information, to the receiving client computer. *Gore* teaches that the server provides the media information. In contrast to *Gore*, claim 1 calls for a first chat module, communicatively coupled to the first application module, for sending the active content.

Direct communications of *Gore* merely provide communications between the server and client to provide the information regarding the media on the local computers. The chat module of *Gore* displays this data from the server. There is no disclosure in *Gore* regarding providing information about active content to the second chat module. In contrast to claims of the present application, *Gore* is not directed to communications with regard to active content between a sender peer and a recipient peer, where the sender peer comprises a first chat module and the recipient peer comprises a second chat module, and wherein the second chat module receives and outputs the active content that is active on the sender peer. *Gore* discloses no such subject matter. *Gore* discloses communications with the server which provides *information* and synchronizing processes to synchronize the operation of individual applications being performed on individual clients. This disclosure does not anticipate all of the elements of claim 1. Therefore, *Gore* does not teach, disclose or suggest all of the elements of claim 1 of the present Application.

Similarly, claim 22 calls for activating media content from a data file at a sender peer and sending real time information about the active data content from the sender peer to a recipient peer through a chat network, and receiving and outputting the active media content of the recipient peer. Again, for at least those reasons cited above, **Gore** simply does not disclose the communications of the active media to the sender peer to the recipient peer via chat modules. The simple communications described in **Gore** along with the client to server communications, does not anticipate this subject matter. Therefore, claim 22 of the present invention, and its respective dependent claims, is also allowable for at least the reasons cited herein. Similarly, claim 33 calls for a computer program product that includes an apparatus for performing various types of sharing steps, such as activating content from the data file at a sender peer and sending information about the active media content in response to getting active content from the sender peer and receiving and outputting the active content at the recipient peer. Again, for reasons cited above, **Gore** does not disclose this communication between the sender peer and the recipient peer, as called for by claim 33 of the present invention. Thus, claim 33 of the present invention, and its respective dependent claims, is also allowable for at least the reasons cited herein. Claims 1, 22 and 33, and all their respective dependent claims, are allowable for at least the reasons cited herein.

The Examiner rejected claims 1-6, 8, 18-24, 27-35, 37-42 and 44 under 35 U.S.C. 102(e) as being anticipated by U.S. Publication 2003/0225834 (**Lee**). Applicant respectfully traverses this rejection.

**Lee** does not disclose or suggest all of the elements of independent claims 1, 22, 33, and 42 of the present invention. **Lee** does not disclose active content communications using first and second chat modules, as called for by the claims. In fact, **Lee** is explicit that active content

communications between chat modules would not work and proposes a solution that is entirely different from the chat modules approach, as called for claims of the present application. *See Lee*, page 7, ¶¶[0066]-[0067]. *Lee* is directed to a file sharing system to share content using multiple communication paths, *i.e.*, a communication path that is separate and distinct from communication path that links chat modules. The communications in *Lee* is between an inviter computer and an invitee computer. *Lee* discloses an “online message path” that is used to attempt to establish a separate communications path for content sharing. *See Lee*, page 7, ¶[0066]. *Lee* is explicit that the inviter computer attempts to set up a separate path for content sharing, and this path may be a “point-to-point tunneling protocol.” *See Lee*, page 7, ¶¶[0064-0066]. The separate, second port used for content sharing session is “a second communication path” that is “defined between the identified port and the invitee computer.” *See Lee*, page 7, ¶[0067]. However, *Lee* fails to disclose a first chat module for sending the active content to a recipient peer.

*Lee* is explicit in disclosing that an “online message service” with “small relatively small amount of bandwidth” is used in setting up the separate communication path for content sharing. *See Lee*, page 7, ¶[0066]. In other words, the message service is not, itself, capable of transmitting content to another client. The limited bandwidth capabilities of the message service prevent such a transfer. In the Advisory Action, the Examiner states that “Applicant's argument that the modules use a second path, does nothing to negate the fact that the modules are clearly communicating.” *See Advisory Action, Continuation Sheet*. Whether the modules of *Lee* are communicating or not is of no moment. Applicant does not contend that the modules in *Lee* are not “communicating.” Rather, Applicant contends that, as discussed above, *Lee* teaches modules with limited bandwidth that do not communicate “content” (as called for in claim 1) through the

modules. As taught in *Lee*, a *separate port* is utilized to transfer content, not the port on which the online messenger service is “communicating.” *See id.* The system disclosed by *Lee* makes it impossible to perform the active content communication between chat modules called for by the claims. Because *Lee* discloses a separate path due to its limited bandwidth capabilities, *Lee* teaches a completely different way of sharing/sending information. *Lee* teaches a separate action altogether. This is in stark contrast to the chat modules called for by claims of the present invention, which provide for sending and receiving the active content of a sender peer. Since *Lee* explicitly indicates that the active content communication between chat modules is impossible due to bandwidth constraints, and describes sending content on an entirely separate and distinct communication path, it necessarily follows that *Lee’s* system is entirely different from the one claimed by the present application. Thus, it is impossible that *Lee* anticipates this feature of the claims. Still further, *Lee* does not disclose any type of substantial real time communications with regards to media content, as called for by some claims of the present application. For at least these reasons, *Lee* does not teach, disclose or suggest all of the elements of claim 1 of the present invention.

Further, claims 22 calls for real time media content sharing through a chat network connection, which as described above, relate to subject matter that is not taught, disclosed or suggested by *Lee*. Claim 33, which calls for communications similar to claim 1 is also not taught, disclosed, or suggested by *Lee* for similar reasons. Claim 42 calls for a graphical user interface (GUI) for outputting content information from a sender peer upon receiving one or more unique identifiers based upon shared active content. *Lee* does not disclose any type of a GUI for outputting active content based upon receiving unique identifiers relating to shared active content. Accordingly, claim 42 is also allowable.

Additionally, the Office fails to produce evidence why those skilled in the art would modify *Lee* in the manner claimed. For at least these reasons, the Office did not show a case of *prima facie* case of obviousness claims of the present application. Under recent United States case law, specifically, *KSR International Co. v. Teleflex Inc.*, 550 U.S.—, 82 USPQ2d 1385 (2007), regardless of the particular rationale used, a finding of unpatentability requires an Examiner to show, among other findings, a finding that one of ordinary skill in the art could have pursued known options or combined known elements *with a reasonable expectation of success*. The Office did not show that those skilled in the art would modify *Lee* with a reasonable expectation of success. In fact, Applicant respectfully submit that those skilled in the art would have an unreasonable expectation of success of active content communications between chat modules since *Lee* explicitly teaches that this would not be possible, and that a second communication path is needed for this purpose. Therefore, the Office did not show a *prima facie* case of obviousness of claims 1-6, 8, 18-24, 27-35, 37-42 and 44.

Independent claims 1, 22, 33, and 42 are allowable for at least the reasons cited herein. Further, respective dependent claims 2-21, 23-32 and 43-44 are also allowable for at least the reasons cited herein.

Claim 2 is allowable for additional features recited therein. Claim 2, depending from claim 1, calls for the second chat module further comprising a client module for requesting a stream of the active content and the first chat module further comprises a server module for sending the stream of active content in response to the request. The Examiner's rejection fails because *Lee* fails to teach at least one of the claimed features. For example, *Lee* does not teach the claimed feature of requesting a stream of the active content. The Examiner argues this feature is taught by *Lee*. See Final Office Action, p.2. In particular, the Examiner argues that a dynamic

download (streaming, according to the Examiner) performed by the receiving machine teaches this feature. *See id.*; *see also Lee*, ¶[0075]. *Lee*, however, teaches that a receiving machine may download a media file from a first machine, and that the receiving machine may begin to play the stored media file before the entire file is received. *See Lee*, ¶[0075]. This disclosure does not amount to subject matter that could anticipate the stream of active content using peer to peer communication of claim 1. In contrast to *Lee*, claim 1 of the present Application calls for requesting a stream of the active content. A stream of active content, for example, would be an audio file from the first machine *as it was being listened to* by a user at the first machine. In *Lee*, the file is played at some later time after it is received, which does not anticipate the stream of active content in claim 1. Therefore *Lee* does not, and cannot, teach the claimed feature of claim 2.

Additionally, claim 2 calls for a server module for sending the stream of active content in response to the request. As discussed above with respect to the claimed feature of requesting a stream of the active content, *Lee* fails to teach or suggest such a feature. In the Advisory Action, the Examiner argues that “Lee clearly disclosed sending a request for the content. *See* [0078]. Clearly this also includes sending the content, since the entire purpose for the request is to receive the content.” Applicant respectfully submits that the Examiner is not viewing the claimed feature in light of the entire claim. *Lee* teaches that files may be shared between clients. *Lee* also teaches that during a file transfer, the receiving client may begin to execute the received file before the entire transfer is complete. In other words, a first client may copy a media file to a second client, and the second client may begin to play the stored portion of the file before the entire file is saved. This disclosure, however, does not describe active content streaming. Streaming does not transfer files between clients. Streaming would allow a first client to view/listen to a file broadcast by a second client without a request to copy the file as in *Lee*. *Lee* teaches file sharing, not

streaming. As such, **Lee** does not, and cannot, teach a server module for sending the stream of active content in response to the request, as called for in claim 2.

For at least the aforementioned reasons, claim 2 is allowable. Claims 3-5 are also allowable for similar reasons.

### **Claims Rejections Under 35 U.S.C. 103**

Claims 9-11, 13-17, 25-26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee** in view of U.S. Patent 7,080,030 (**Elgen**). Applicant respectfully traverses this rejection.

Applicant respectfully asserts that **Lee**, **Elgen**, and/or their combination do not teach or disclose all of the elements of claim 1 of the present invention. In order to establish a prima facie case of obviousness, the Examiner must consider the following factors: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP § 2143 (2005) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). In making an obviousness rejection, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, at 14, No. 04-1350 (U.S. 2007). Applicant respectfully submits that the Examiner has not met this burden. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established in rejecting claims -11, 13-17, 25-26 and 36.

The Examiner uses **Elgen** to argue obviousness relating to supplements related to the active contents and/or content enhancement server of claims 9-11, 13-17, 25-26 and 36. Firstly,

adding **Elgen** does not make for **Lee's** deficit relating to the supplements related to the active contents and/or content enhancement server. **Elgen** is directed to digital online communications. **Elgen** does not even mention chat modules except for a passing reference that lists a chat program among various applications that may reside in a computer. **Elgen** discloses a music database that may store information relating to the name of the song, the artists, etc., within the music database, but does not disclose a content supplement database. The Examiner seems to argue that because the music database contains additional information, such as artist name, this suffices for a supplemental database as disclosed in the claims of the instant Application. However, **Elgen** fails to disclose the supplemental database, as described in the claims and the specification. As defined in the specification, the supplemental database may provide other information related to the active content, such as advertisements or books about the authors of the active content. See Specification, ¶[0056]. Further, as show above, **Lee** does not disclose other elements of the independent claims from which 9-11, 13-17, 25-26 and 36 respectively. Still further, the Examiner failed to identify the reasons why those skilled in the art would combine **Lee** and **Elgen** in a manner provided in the claims 9-11, 13-17, 25-26 and 36. Accordingly, the Examiner failed to provide a *prima facie* case of obviousness of claims 9-11, 13-17, 25-26 and 36. Therefore, claims 9-11, 13-17, 25-26 and 36 are allowable for at least the reasons cited herein.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee** in view of U.S. Patent 6,385,596 (**Wiser**). The Examiner also rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over **Lee** in view of **Elgen**, as applied to claim 9 and further in view of **Wiser**. Applicant respectfully traverses these rejections. Adding the preview disclosure of **Wiser** to the disclosure of **Lee** and **Elgen** would not make the elements of claims 43 and 12. The data streams

called for by claims 12 and 43 are not made obvious by **Wiser, Lee** and/or **Elgen**. As described above, the underlying independent claims (1 and 42), from which claims 12 and 43 respectively depend are not made obvious by **Lee**, and **Wise** and/or **Elgen** do not make up for this deficit. Further, the Examiner has failed to identify the reasons why those skilled in the art would combine **Lee, Wiser** and **Elgen** in a manner provided in the claims 12 and 43. *KSR Int'l Co. v. Teleflex, Inc.*, at 14. Accordingly, the Examiner failed to provide a *prima facie* case of obviousness of claims 12 and 43. Therefore, claims 12 and 43 are allowable for at least the reasons cited herein.

For at least the aforementioned reasons, claims 1-44 are allowable. For similar reasons, the remaining claims are also allowable.

Reconsideration of the present application is respectfully requested.

Applicant respectfully asserts that in light of the arguments provided throughout the prosecution of the present application, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued. Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, **the Examiner is respectfully requested to call the undersigned attorney** at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON, P.C.  
CUSTOMER NO. 23720

Date: November 10, 2008

By: /Jaison C. John/  
Jaison C. John, Reg. No. 50,737  
10333 Richmond, Suite 1100  
Houston, Texas 77042  
(713) 934-4069  
(713) 934-7011 (facsimile)  
ATTORNEY FOR APPLICANT(S)